

This Opinion is Not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re OMT Belforte S.R.L.

Serial No. 79255285
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Nicholas D. Wells of Legends Law Group PLLC
for OMT Belforte S.R.L.

Tina Brown, Trademark Examining Attorney, Law Office 118,
Michael W. Baird, Managing Attorney.
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Before Wellington, Kuczma and Heasley,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

OMT Belforte S.R.L. (“Applicant”) seeks registration on the Principal Register of

Victoria Arduino

the mark , for the following goods in International Class

7:¹

Electric coffee grinders; power-operated coffee grinders; pepper mills, other than hand-operated; electric spice grinders; food processors, electric; electric coffee frothers; electric milk frothers; beverage making machines,

¹ Application Serial No. 79255285, filed March 28, 2019 under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a), requesting extension of protection based on International Registration No. 1458072.

namely, aerated beverage making machines, machines for making aerated, fruit-based, soft drink beverages; electric mixers for household purposes; electric food whisks for household purposes; electric food blenders; graters, electric; vending machines.

Applicant has attested that the name shown in the mark, “Victoria Arduino,” does not identify a particular living individual.

The Examining Attorney has partially refused registration of Applicant’s mark with respect to the goods: “electric coffee grinders; power-operated coffee grinders; food processors, electric; electric food blenders.” The refusal, under Section 2(d) of the Trademark Act (“the Act”), 15 U.S.C. § 1052(d), is based on a likelihood of confusion between Applicant’s mark for these objected-to goods with the registered standard character mark **VICTORIA** for “electric juicers; electric food processors; electric food blenders; electric food blenders for household purposes; electric coffee grinders; electrical coffee grinders; power operated coffee grinders; electric meat grinders; electric knives; electric can openers; gas operated blow torches; electric food choppers,” in International Class 7.²

When the refusal was made final, Applicant appealed. The appeal is briefed.

We affirm the partial refusal to register.

I. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on likelihood of

² Registration No. 5739952; registered April 30, 2019. The registration identifies goods in other International Classes, but the Examining Attorney does not rely on those other identified goods to support the refusal.

confusion. *In re E. I. DuPont de Nemours & Co*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”) cited in *B&B Hardware, Inc. v. Hargis Ind., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015); *see also In re Majestic Distilling Co. Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *DuPont* factor for which there is argument and evidence. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019); *M2 Software, Inc. v. M2 Commc’ns., Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). “Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010).

A. Identity of Goods and Trade Channels

Under the second *DuPont* factor we consider “[t]he similarity or dissimilarity and nature of the goods or services,” and under the third factor we consider “[t]he similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 177 USPQ at 567; *see also In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018). We must base our comparison of the goods on the identifications in the cited registration and Applicant’s application. *See Stone Lion Capital Partners v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir.

1997); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Here, Applicant's "electric coffee grinders and power-operated coffee grinders" are identical to or encompassed by (and thus legally identical to) Registrant's "electric coffee grinders, electrical coffee grinders, power operated coffee grinders." In addition, Registrant's and Applicant's identifications of goods include the identical items: electric food processors and blenders. Applicant does not deny that the objected-to goods are identical.

Because the relevant goods in the application are identical or legally identical to those listed in the cited registration, without any restriction as to trade channels, we must also presume that these goods travel in the same ordinary trade and distribution channels and will be marketed to the same classes of potential consumers. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *13-14 (TTAB 2020). The relevant consumers include the general public, inasmuch as coffee grinders, blenders and food processors are standard kitchen appliances. Thus, the trade channels overlap and the goods will be offered to ordinary consumers.

We accordingly find the *DuPont* factors regarding the goods, channels of trade and classes of purchasers weigh strongly in favor of finding a likelihood of confusion.

B. Similarity of the Marks

Under the first *DuPont* factor, we consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *Stone Lion Capital Partners v. Lion Capital*, 110 USPQ2d 1160; *DuPont*, 177 USPQ at 567. Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d mem.*, 777 F. App’x. 516 (Fed. Cir. 2019).

The issue is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression such that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

We also keep in mind that “[w]hen the goods are identical, the appearance of a mark of similar sound, appearance, or connotation is more likely to cause confusion than if the goods are significantly different.” *Bridgestone Americas Tire Operations*,

LLC v. Fed. Corp., 673 F.3d 1330, 1337, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012); *see also New Era Cap v. Pro Era*, 2020 USPQ2d 10596, at *14.

At the outset, we find the dominant element of Applicant's mark, , is the name VICTORIA ARDUINO. The winged or V design element is not very distinctive and visually serves as carrier underlining the name. *In re Viterra*, 101 USPQ2d 1911 (“the verbal portion of a word and design mark likely will be the dominant portion ... given that the literal component of brand names likely will appear alone when used in text and will be spoken when requested by consumers.”); *Bos. Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1591-92 (TTAB 2007) (“It has frequently been stated that it is the word portion of marks, rather than the particular display of the words, that is likely to have a greater impact on purchasers and be remembered by them.”). *See also In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) (“It is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to the dominant feature in determining the commercial impression created by the mark as long as the mark is considered in its entirety.”).

In comparing Applicant's mark to the registered mark, VICTORIA, we note the aural and visual similarities between them, given that Applicant's mark begins with the name “Victoria.” *See also Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (“[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.”) As to the stylized lettering in Applicant's mark, it

is not very distinctive and, in any event, Registrant's mark is in standard characters which means it can be displayed in the same or very similar font. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (standard character registrations "are federal mark registrations that make no claim to any particular font style, color, or size of display and, thus, are not limited to any particular presentation," citing 37 C.F.R. § 2.52).

Applicant acknowledges that its mark begins with same given name that forms the entirety of the registered mark, but argues that the marks "differ sufficiently to avoid any likelihood of confusion."³ In support, Applicant cites *Paco Sport, Ltd. v. Paco Rabanne Parfums*, 86 F.Supp.2d 305, 54 USPQ2d 1205 (S.D.N.Y. 2000), a decision involving an infringement claim and finding no likelihood of confusion between the marks PACO RABANNE for fragrances and PACO for clothing.

Relying on this decision, Applicant argues:⁴

Applicant respectfully submits that the same logic used in the cases discussed above should apply here. Specifically, the logic used in the single precedential case cited above, which related to a single undefined name—PACO—as compared to the full name of a specific person-- PACO RABANNE—should apply here. That is, consumers are highly likely to distinguish the single common first name VICTORIA from the name of a specific person, VICTORIA ARDUINO. Indeed, the unusual Italian surname ARDUINO is particularly likely to impress itself upon consumers' minds in order to distinguish the marks.

The district court's *Paco Rabanne* decision has little bearing on our decision in this appeal. Simply put, in that case, the court expressly relied upon several factors

³ 4 TTABVUE 2.

⁴ *Id.* at 4.

and key evidence that are not present here. For example, the goods involved—clothing versus fragrances—were not only different, but the court also found that the “competitive distance between the products is significant” and “[t]here is no actual or perceived likelihood that Paco Rabanne will bridge the gap.” *Id.* at 1225. The court further found that “[t]he sophistication of relevant consumers further reduces the likelihood of confusion.” *Id.* Because several additional factors and evidence were present in the *Paco Rabanne* case, we are not persuaded, as Applicant urges, to apply “the same logic” in this case.

In this case, Registrant’s mark is the name VICTORIA, while the dominant element of Applicant’s mark is the name VICTORIA ARDUINO. The record shows no third-party use of the shared first name, “Victoria,” with or without a surname, in connection with the same or similar goods. There are also no third-party registrations for marks with the name “Victoria” in the record.⁵ As such, we have no evidence to suggest that Registrant’s mark, VICTORIA, possesses any weakness other than being suggestive of a person’s first name perhaps associated with the goods. In this regard, we must consider the scenario when consumers already familiar with Registrant’s mark VICTORIA encounter Applicant’s mark, VICTORIA ARDUINI (stylized with design) used on identical goods such as electric coffee grinders, electric food processors and food blenders. We find that consumers are likely to mistakenly believe

⁵ In addition to the cited registration, the Examining Attorney also cited Registration Nos. 4494141, 5206145, and 6002955 as bars, or potential bars, to registration. Copies of these additional registrations were attached to the April 3, 2019 and May 25, 2020 Office Actions. These three registrations, and the cited registration, are owned by Registrant.

both marks refer to the same individual, with one mark providing the full name and the other abbreviated to just the given name. In other words, the mark VICTORIA is likely to be perceived as a shortened reference to Applicant's VICTORIA ARDUINO.

In comparing the marks in their entireties, as we must, we find them overall to be similar. Accordingly, we find this *DuPont* factor also weighs in favor of a likelihood of confusion.

C. “Coexistence” of the Marks; Applicant’s Prior Registration and Claim of a Famous Mark

Applicant argues that because the cited registration “includes a date of first use in commerce, as to Class 07, of 1994” and Applicant “is also the owner of U.S. Reg. No. 2631365 for the standard character mark VICTORIA ARDUINO in Class 11 for “Electric coffee makers for domestic and commercial use,” the marks “have co-existed for over 25 years.”⁶ Applicant further asserts that “[d]uring the period from 1994 to the present, Applicant is not aware of any actual confusion between the two subject marks.”⁷ Finally, Applicant contends that “the fame of Applicant’s mark as one of the leading brands of Italian-made espresso machines (founded in 1905) is a further factor in ensuring that consumers will distinguish between the VICTORIA ARDUINO mark and the VICTORIA mark.”⁸

Applicant’s arguments are not supported by evidence. Indeed, Applicant did not submit a copy of its prior registration and, as the Examining Attorney points out,

⁶ 4 TTABVUE 4.

⁷ *Id.* at 5.

⁸ *Id.*

Applicant did not claim this registration “at any other time in the application record prior to filing this appeal.”⁹

Inasmuch as the Examining Attorney did not object to Applicant’s late claim of the prior registration and, in fact, acknowledges Applicant’s ownership thereof,¹⁰ we treat Applicant’s prior registration as being of record. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1207.03 (June 2021). Nevertheless, we agree with the Examining Attorney that Applicant’s ownership of the registration does not create the type of “unique situation” where the Board has previously found no likelihood of confusion. *Cf. In re Strategic Partners, Inc.*, 102 USPQ2d 1397, 1399-1400 (TTAB 2012). In *Strategic Partners*, the Board found no likelihood of confusion because the marks in applicant’s prior registration and application were virtually identical (“no meaningful difference”) existed between them, such that they were “substantially similar”); the goods were identical in relevant part; and the prior registration had co-existed for a substantial time with the cited registration. *Id.* Here, however, the objected-to goods in the involved application, i.e., “electric coffee grinders; power-operated coffee grinders; food processors, electric; electric food blenders,” are not identical to the goods in Applicant’s prior registration, i.e., coffee makers. Thus, the unique circumstances that the Board relied upon for finding no likelihood of confusion in *Strategic Partners* are not present in this appeal.

⁹ 6 TTABVUE 12.

¹⁰ *Id.*

As to Applicant's reliance on a putative lengthy period of coexistence of Applicant's and Registrant's marks without any instances of actual confusion, we point out that, generally, the "lack of evidence of actual confusion carries little weight, especially in an ex parte context." *Majestic Distilling*, 65 USPQ2d at 1205. That is the case here because there is insufficient evidence regarding the extent of usage of the marks to conclude that that there has been a meaningful opportunity for confusion to have occurred. *Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at *9 (TTAB 2019) (explaining that "for the absence of actual confusion to be probative, there must have been a substantial opportunity for confusion to have occurred"); *Barbara's Bakery Inc. v Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred). Applicant's assertions in its brief do not suffice as "[a]ttorney argument is no substitute for evidence." *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018). Nor do we know whether Registrant is aware of any instance of actual confusion; "in this ex parte context, there has been no opportunity to hear from Registrant about whether it is aware of any reported instances of confusion." *In re Guild Mortg.*, 2020 USPQ2d 10279, at *23. Accordingly, we find this factor neutral.

Lastly, as to Applicant's claim that its mark is famous, we point out that it is fame of the prior mark (*i.e.*, the mark in the cited registration), not the applicant's mark, that must be considered when evidence of fame is of record. *DuPont*, 177 USPQ at 567 ("fame of the prior mark.").

II. Conclusion

Because the marks are similar, the involved goods are identical and will presumably be offered in the same channels of trade to the same classes of consumers, we find that Applicant's mark  for "electric coffee grinders; power-operated coffee grinders; food processors, electric; electric food blenders," is likely to cause confusion with the registered mark VICTORIA for goods that include "electric [and] power-operated coffee grinders" and "electric food processors [and] blenders."

Decision: The partial refusal to register Applicant's mark under Section 2(d) of the Trademark Act, as to "electric coffee grinders; power-operated coffee grinders; food processors, electric; electric food blenders," is affirmed.